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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,281	09/10/2003	Lance R. Peterson	0112300-1529	5293
29159 7590 09/17/2008 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER PANDYA, SUNT				
ART UNIT 3714		PAPER NUMBER		
NOTIFICATION DATE 09/17/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/660,281

Applicant(s)

PETERSON ET AL.

Examiner

SUNIT PANDYA

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-17, 20-49, 81, 82, 84-87 and 89-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-17, 20-49, 81-82, 84-87, 89-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to amendment filed 29 May 2008. The examiner acknowledges the amendments made to claims 1, 9, 13, 21, 25, 81, 82, 91 & 93. Furthermore claims 6, 18, 19, 83 & 88 have been canceled and claims 95 & 96 are added.

Terminal Disclaimer

The terminal disclaimer filed on 5/29/08 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6/23/08 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 9-17, 21-49, 81, 82, 84-87, 89 and 91-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (US Patent 6,589,114).

Claims 1, 13, 25, 81, 95-96: Rose teaches a game of chance conducted on video gaming machine controlled by a processor in response to a

wager. The game includes a plurality of symbols randomly selected for placement in a displayed symbol array. A shuffle feature is triggered in response to the displayed symbols including a sequence of value-based symbols. The sequence defines a first award. The sequence of value-based symbols is then re-ordered such that the re-ordered sequence defines a second award. The second award is awarded to the player. Furthermore, the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction, to define the award given to the player. Rose additionally discloses, a display device (figures 1, element 12), a plurality of digits displayed on the display device (figure 4), a processor which communicates with the display device, which selects and displays a plurality of digits, enables a player to select the positions (wherein player selectable digits could be the player's selection of paylines to be activated during the game play, as well as displaying a number associated with each selection in the digit selected by the player see figures 3-7, column 3-4, line 51-57, and column 5, lines 1-9), which associates numbers with the positions based on the player's selection of the positions and which determines an award based on an order of the numbers associated with the positions, wherein the award is based on a number of monetary units equal to the order of the numbers associated with the positions (figures 3-7, column 3-4, lines 51-57, and column 5, lines 1-9, Rose teaches of a processor programmed to enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of an award provided to the player {column 3-4, lines 51-57, and column 5, lines 1-9}).

Claims 2-3, 14-15, 26-28, 30, 84-85: Rose teaches of the display device being a video display reel (reels which are projected to be circular on the game machine), not mechanical device (column 2, lines 28-30). However it is notoriously well known in the art to adapt video reel over mechanical reels thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 4, 17, 86: Rose teaches of a gaming device which includes an initial sequence controlled by the processor for determining how many positions the player is enabled to select (columns 4-5, line 66-3).

Claims 5, 87: Rose teaches of a gaming device wherein the award positions include at least a one's digit, a ten's digit and a hundred's digit (figures 3-7 and columns 4-5, lines 1-9).

Claims 16: Rose teaches of a gaming machine wherein the processor reveals the award by displaying a number associated with each selection in the digit selected by the player (figures 3-7, column 3-4, line 51-57, and column 5, lines 1-9).

Claims 7, 88: Rose teaches of the numbers are digits and the award is a number of credits which is the order of the digits (Abstract, column 4, lines 21-25).

Claims 9-12, 22-24, 91-94: Rose teaches of a shuffle feature includes a sequence of value-based symbols that are randomly re-ordered/shuffles, with or without player interaction (such as player selection) (column 3-4, lines 51-57, and column 5, lines 1-9).

Claims 21, 89: Rose teaches of a gaming machine, wherein the processor is programmed to enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of an award provided to the player (column 3-4, lines 51-57, and column 5, lines 1-9).

Claim 29: Rose teaches of a gaming device which includes a plurality of selections displayed by the display device, which enables a player to associate the selections with the positions, which causes the display device to display the numbers associated with the selections that have been ordered in association with the positions (60) (62) (64) (figures 3-7, column 3-4, lines 51-57, and column 5, lines 1-9).

Claim 31: Rose teaches of a gaming device comprising a cabinet (figure 1), a display device supported by the cabinet having plurality of different modification methods (the game includes a plurality of symbols randomly selected for placement in a displayed symbol array. A shuffle feature is triggered in response to the displayed symbols including a sequence of value-based symbols). An indicator disclosed within the cabinet to indicate modifications (column 3-4, lines 51-57, and column 5, lines 1-9). Rose also teaches of displaying award determined by the processor and provided to the player based on the order of the numbers arranged by the player (Abstract, column 4, lines 21-25, and Claim 6), wherein the modified award includes the award modification method which is the award rearrangement method (shuffle feature) (column 3-4, lines 51-57, and column 5, lines 1-9).

Rose teaches of the display device and the award indicators as being a video display, not mechanical device (column 2, lines 28-30). However it is notoriously well known in the art to adapt video display means over movable mechanical means, thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 32, 33, 35: Rose teaches of a gaming device which includes a player selectable modify input which communicates with the processor, wherein activation of the modifying input initiates an award modification method, wherein the award modification method is an award rearrangement method (shuffle feature) (column 3-4, lines 51-57, and column 5, lines 1-9).

Rose teaches of the display device and the award indicators as being a video display, not mechanical device (column 2, lines 28-30). However it is notoriously well known in the art to adapt video display means over movable mechanical means, thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 34, 36-41: Rose teaches of the display device being a video display reel (wherein the reels which are projected to be circular on the game machine), are not mechanical devices (column 2, lines 28-30). However it is notoriously well known in the art to adapt video reel over mechanical reels (wherein the mechanical reels could be conformed to any shapes such as circular, prism shaped, extend latitudinally, or longitudinally, spinning vertically or horizontally, which are all with the capabilities of video reels) thus making the gaming machines more efficient and less inclined to any mechanical problems.

Claims 42-49: Rose discloses of a shuffle feature, which includes sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection, or when the processor automatically controls the feature), to define the award given to the player.

Claim 82: Rose teaches of a gaming device wherein a selection order enables the player to select and order at least two selections with digits to form an award, wherein the processor reveals the award by displaying a number associated with each selection in the digit selected by the player (column 3-4, lines 51-57, and column 5, lines 1-9).

Claims 8, 20 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. 6,589,114) as applied to claims above, and further in view of Hamano (U.S. 5,205,555).

Claims 8, 20, 90: Rose substantially teaches the invention as claimed however, Rose seems to lack awards being based on mathematic operation applied to digits.

Hamano teaches of a gaming machine that determines an award for a player by performing a mathematical computation of the numbers that stop on the top line of reels of a gaming machine. Hamano is analogous art because, like Rose, is an electronic gaming device.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Hamano's process for determining and calculating a player award in a gaming machine in Rose. Doing

so, one would be motivated to incorporate Hamano's process for determining and calculating a player award in Rose to provide an electronic game that is complicated and more interesting than simply relying on an award paid in response to a predetermined or player determined combination that is in a one to one, fixed relationship with a predetermined stored pay table in the gaming machine.

Response to Arguments

Applicant's arguments filed 5/29/08 have been fully considered but they are not persuasive.

The applicant argues that Rose does not teach of the invention as disclosed in the newly amended claims submitted by the applicant on 29 May 2008. The examiner respectfully disagrees with the applicant, and would like to direct the applicant's attention to the rejection of the independent claim which has been updated by the examiner to reflect the amendments.

With regards to applicant's that Rose disclose determining and display an award based on an order of the digits associated with the digit positions selected by the player, as disclosed in claim 1. The examiner respectfully disagrees with the applicant. As noted in the rejection above, Rose teaches of a game of chance conducted on video gaming machine controlled by a processor in response to a wager. Rose additionally teaches, a display device (figures 1, element 12) to display a plurality of digits, a processor which communicates with the display device, which enables a player to select the positions (wherein player

selectable digits could be the player's selection of paylines to be activated during the game play, as well as displaying a number associated with each selection in the digit selected by the player see figures 3-7, column 3-4, line 51-57, and column 5, lines 1-9), which associates numbers with the positions based on the player's selection of the positions and which determines an award based on an order of the numbers associated with the positions

Regarding the applicant's arguments that Rose lacks the mechanical display device including the movable mechanical display device, support cabinet for said display device, and plurality of different modification methods, the examiner respectfully disagrees. As noted in *In re Venner* 120 USPQ 192, it has been held that broadly providing a electrical means to replace a mechanical means are equivalent and only require routine skill in the art, it would be within one of ordinary skill in the art's grasp to implement electrical components instead of mechanical to reduce problems and error created by mechanical devices. However the modification methods for both mechanical and electrical device would remain the same, as to the method associated with the modification would not change just because a certain digits are displayed in electrical display rather than mechanical display.

Consequently, the rejection has been maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **SUNIT PANDYA** whose telephone number is (571)272-2823. The examiner can normally be reached on **M-F 8 - 5:30**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Robert Pezzuto** can be reached on **571-272-6996**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

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